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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/400,757	09/21/1999	GARY S. HAHN	246/221	3773

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EXAMINER	
WANG, SHENGJUN	
ART UNIT	**PAPER NUMBER**
1617	

DATE MAILED: 11/05/2002 18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/400,757	HAHN ET AL.	
	Examiner	Art Unit	
	Shengjun Wang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 August 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25,52,55,57,58,61-69,77-80,84,85 and 98-114* is/are pending in the application.

4a) Of the above claim(s) *19, 20, 62-69,77-80,84,85 and 98-114* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18,21-25,52,55,57,58 and 61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Applicant's election without traverse of invention group 1, claims 1-25, 52, 55, 57, 58 and 61, and organic acid as the elected species in Paper No. 17, submitted August 9, 2002 is acknowledged.

2. Claims 62-69, 77-80, 84, 85, 98-114 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, and 19 and 20 are withdrawn from further consideration as being drawn to nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 15 and 17.

Double Patenting Rejections

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-18, 21-25, 52, 55, 57, 58 and 61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42, and 70-80 of U.S. Patent No. 5,958,436. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims herein are generic to the subject matter claimed in patent '436.

Claim Rejections 35 U.S.C. 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-5, 12, 21 and 24 rejected under 35 U.S.C. 102(e) as being anticipated by Chow et al. (U.S. Patent 5,476,647)

7. Chow teaches a topical application comprising water, acetic acid and about 300mM of calcium chloride. The pH of the composition is 6.

8. Claims 1-3, 12, 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Ito et al (U.S. Patent 5,709,849).

9. Ito teaches a cosmetic composition comprising lactic acid, and 0.5% of calcium chloride. See, table 1 in column 3.

Claim Rejections 35 U.S.C.§ 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1-18, 21-25, 52, 55, 57, 58 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cormier et al (5,624,415) in view of Ito (U.S. Patent 5,709,849), Giddey et al. (U.S. Patent 5,053,219), Cook et al. (U.S. Patnet 2,719,811) and Henderson (U.S. Patent 5,296,476).

12. Cormier et al. teaches a topical composition with reduced irritation comprising organic acids and inorganic salts, including calcium chloride, with pH at 4-10, wherein the inorganic salt may be about 0.4 M to 0.6 M. See, particularly, the abstract, example VIII in column 28, the table 9, and the claims.

13. Cormier et al does not teach expressly the employment of calcium, or the particular amount of the calcium, organic acid, or the other known cosmetic ingredients herein.

14. However, Cook et al. teaches that calcium metal with hydroxy acids are known to be beneficial for skin. See, particularly, column 2, lines 30-40, lines 63-72, and claims 4-5. Henderson teaches that calcium citrate are particularly useful with salicylic acid in topical application. See, particularly the claims. Ito also teaches the usefulness of organic salts of calcium in cosmetic products. See, particularly, the abstract, and the claims. The organic salt may be produced in situ, i.e., employing an inorganic calcium salt (e.g., calcium chloride) and an organic acid in the cosmetic composition, see, particularly, table 1. Giddey et al. teaches

cosmetic composition having an organic acid (0.5-4% by weight) and calcium cation (0.1-1%, by weight).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ calcium salts in the topical composition, and further, employ calcium cation with organic acid in cosmetic composition, wherein the acid may causing irritating.

1. A person of ordinary skill in the art would have been motivated to employ calcium salts in the topical composition, and further, employ calcium cation with organic acid in cosmetic composition, because calcium are known to be similarly useful amount the few disclosed cation in Cormier. The employment of calcium herein is seen to be a selection from amongst equally suitable material and as such obvious. Ex parte Winters 11 USPQ 2nd 1387 (at 1388). Further, A person of ordinary skill in the art would have been motivated to employ calcium as the divalent metal in cosmetic composition, wherein a hydroxy acid is required because calcium with organic acid are known to provide benefit to skin, and calcium cation is particularly known to be useful in some cosmetic product. The employment of other well-known cosmetic or topical ingredients, such as sulfate, nitrate, second anti-irritant agent, steroid, etc, in the topical composition is considered obvious and is with the skill of artisan.

2. Regarding the functional limitation of the claimed composition, note it is well settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to In re Swinehart, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated "is elementary that the mere recitation of a newly discovered function or property, inherently possessed by thing in the prior

art, does not cause a claim drawn to those things to distinguish over the prior art." In the instant invention, the claims are directed to the ultimate utility set forth in the prior art, albeit distanced by various functional limitaiton. The ultimate utility for the claimed combination of organic acid andcalcium is old and well known rendering the claimed subject matter obvious to the skilled artisan. It would follow therefore that the instant claims are properly rejected under 35 USC 103.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Examiner

S. Wang

Shengjun Wang

November 2, 2002